

Atty. Dkt. No. 200209331-1

## **REMARKS**

This Reply is in response to the Office Action mailed on October 24, 2005. In view of the following remarks, reconsideration and allowance of the pending claims is requested.

### **I. Claim Objections**

Paragraph 1 of the Office Action alleges that claim 2 "recites idiomatic English in line 3." The Office Action does not identify the specific language in claim 2 to which the claim objection is directed. Further, the Office Action does not specify the language regarded as an idiom. To the extent the objection to the claim 2 is maintained in a subsequent Office Action, Applicants request identification of the language to which the objection is directed as well as a basis for finding the language of claim 2 objectionable. Because the language of claim 2 is not objectionable and the Office Action fails to establish otherwise, Applicants request withdrawal of the objection to claim 2.

Claim 7 is cancelled, thus rendering moot the objection thereto.

Regarding claim 13, the Office Action states that "Claim 13 recites a printing device in the preamble, but does not recite printing means." Applicants traverse this objection on the basis that there is no requirement that claim 13 recite "printing means." Applicants also note that claim 13 recites an "image-transfer mechanism." As such, because Applicants are not required to recite "printing means" in claim 13 and because claim 13 recites "an image-transfer mechanism," Applicants request withdrawal of the objection to claim 13.

The Office Action also states that "Claim 13 recites a printable media sheet, what is meant by printable." Applicants are amending claim 13 to replace "printable media sheet" with "media sheet" and submit that the objection to claim 13 is overcome. Withdrawal of this objection is requested.

Claims 14, 16, and 17 are objected to in paragraph 1 of the Office Action, but no explanation is provided for the objection to these claims. As such, Applicants request withdrawal of the objections to these claims.

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## II. Drawings

In the Office action, the drawings are objected to under 37 CFR 1.83(a) as failing to show the "automatic feed tray" and the "alternative transfer bypass path". The Examiner asserts that these features "must be shown or the features cancelled from the claims." The Examiner does not specify where these features are found in the claims.

Based on Applicants' review of the claims, it appears that the Examiner is referring to claims 9 and 13. Claim 9 recites "receiving the media sheet and at least one laminate material sheet from an automatic feed tray of the printing device." Claim 13 recites "a selectively operable bypass of the image-transfer mechanism." Both claims include language originally present in the claims (claim 13 incorporates language from original claim 15).

Applicants note the Examiner's previous indication that the "drawings filed 1-23-04 are approved by the examiner."

Regarding the Examiner's assertion that the drawings do not show an "automatic feed tray", Applicants respectfully disagree. As set forth clearly in Applicants' specification, "[p]rinting device 10 includes one or more automatic feed media trays 22..." (Specification, page 2, line 32 thru page 3, line 1). As also indicated, "the printing device may include laminate material in one of the automatic feed trays and print media in another automatic feed tray" (Specification, page 4, lines 3-5). The drawings thus clearly do show "an automatic feed tray of the printing device as set forth in claim 9.

Regarding the Examiner's assertion that the drawings do not show an "alternative transfer bypass path", Applicants note that such language is not found in the claims. Applicants presume that the Examiner is referring to language in claim 13, which recites "selectively operable bypass of the image transfer mechanism." As noted in Applicants' specification, such bypass (also referred to as "pass through") need not necessarily be mechanical (as the Examiner apparently presumes). Bypass may be achieved "by not charging the composite media, or not scanning the laser across the photoreceptor, or a

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combination of these" (Specification, page 5, line 31 thru page 6, line 1). The specification was nevertheless amended in a prior Reply to make this more clear.

Based on the foregoing, the objections to the drawings under 37 CFR 1.83(a) should be withdrawn.

III. Claim Rejections – 35 USC § 103.

Paragraph 5 Of the Office Action rejects claims 1-8, 12-14, and 16-17 as unpatentable over Endo et al. (5,894,318) in view of Hooper et al. (6,816,686). Applicants submit that the present application and the Hooper et al. (6,816,686) reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person(s) or organization(s). Accordingly, Hooper et al. (6,816,686) is disqualified as a reference under 35 USC § 103(c). See MPEP 706.02(I)(3). Consequently, given the disqualification of the Hooper et al. (6,816,686) reference, Applicants request withdrawal of the rejection of these claims.

Paragraph 6 of the Office Action rejects claims 10-11 as being unpatentable over Endo et al. in view of Hooper et al. in view of Fukushima. Given the disqualification of the Hooper et al. reference discussed above, Applicants request withdrawal of the rejection of claims 10-11. Withdrawal of these rejections is requested.

IV. Allowable subject matter

Paragraph 7 of the Office Action states that claim 9 is allowed. Applicants gratefully acknowledge the allowance of claim 9.

V. Conclusion.

Applicants believe that the present application is in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.138 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,  
Carlson et al.

Date

11/17/05

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I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Alexandria, VA, on 11-18-05, to PTO fax no. (571) 273-8300.

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